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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,419	02/22/2002	Dwight Williams	50051	1039
22929	7590	01/09/2009		
SHAPER ILER LLP 1800 WEST LOOP SOUTH SUITE 1450 HOUSTON, TX 77027			EXAMINER GANEY, STEVEN J	
			ART UNIT 3752	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DWIGHT WILLIAMS

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Application 10/081,419  
Technology Center 3700

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Mailed: January 9, 2009

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Before PAMELA S. BENNETT *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on May 31, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

**APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER**

Appellant filed an Appeal Brief dated October 11, 2006. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v) (2006), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

On October 25, 2006, a “Notification of Non-Compliant Appeal Brief” was mailed which stated that “[t]he summary of claim[ed] subject matter fails to map each independent claim to the specification by page and line number and to the drawings, if any.” In response, a revised “Summary of claimed subject matter” was filed on November 1, 2006. However, this revised “Summary” is still deficient because it fails to map independent claim 17 to the specification “by page and line number and to the drawings, if any” as required by 37 CFR § 41.37(c)(1)(v) (2006). Correction is required.

**APPEAL BRIEF, EVIDENCE APPENDIX**

37 CFR 41.37 (2006) states, in part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

....

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

The Appeal Brief filed October 11, 2006 is not in compliance with the above because the “Evidence appendix” page is blank<sup>1</sup> and it is unclear whether

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<sup>1</sup> The *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 3, August 2005) states that “[i]f there is no evidence being relied upon by appellant in the appeal, then an evidence appendix should be included with the indication “none”.”

the pages following the “Related proceeding appendix” are part of the “Evidence appendix.” If these pages are part of the “Evidence appendix,” the Evidence appendix is deficient because it does not include a statement which sets forth where in the record the evidence was entered by the examiner. Correction is required.

### **CONCLUSION**

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellant to file a revised Appeal Brief which corrects the “Summary of claimed subject matter,” and “Evidence Appendix” of the Appeal Brief filed October 11, 2006;
- 2) for consideration and acknowledgement of the revised Appeal Brief, and
- 3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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